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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,697	08/08/2006	Katsuhira Yoshida	VX062747 PCT	9922
23400 7590 12/11/2007 POSZ LAW GROUP, PLC 12040 SOUTH LAKES DRIVE SUITE 101 RESTON, VA 20191			EXAMINER CHANDRAKUMAR, NIZAL S	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,697	YOSHIDA ET AL.	
	Examiner	Art Unit	
	Nizal S. Chandrakumar	1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 5-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

This application filed 08/08/2006 is a 371 of PCT/JP05/02026 02/10/2005.

Claims 1-12 are before the Examiner.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-4, drawn to heteropolycyclic compounds.

Group 2, claim(s) 5-12, drawn to colorant comprising compounds of group 1.

The inventions listed as Groups 1-2 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the common technical feature in all groups is the 4-aminated,4-arylated,naphthaquinone structure. This element cannot be a special technical feature under PCT Rule 13.2 because this element is shown in the prior art. See Yoshida et al. Journal of Chemical society, Perkin Transactions 1, 1990, pages 1891-1895.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction were not required; because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

During a telephone conversation with attorney for the applicant Mr. Eugene Varndell (703) 701-9110 on 12/06/2007 a provisional election was made to examine the invention of Group 1, claims 1-4.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Affirmation of this election must be made by applicant in replying to this Office action. Claims 5-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 and 9-21 of copending Application No. 1054319.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are drawn to compounds of similar structures and colorant properties.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite substitutions without defining what these substitutions are.

The claims define Z as 'divalent group'. This is unclear because any chemical moiety other than H is at least divalent. Clear definition what the applicant is seeking protection for is required.

It is unclear if a compound in which X being H would be a colorant. This compound would be a phenol. No evidence is present in the specification to the contrary. In this context, applicant's attention is drawn to the usage of the term 'tautomeric' on page 13, line 5 of the specification. This would be technically incorrect if the error in the chemical structure of compounds on page 13, line 7 is not corrected.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and dependent claims 5-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a limited number of compounds of the formula, does not reasonably provide enablement for the plurality of possible structures claimed. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the

invention commensurate in scope with these claims. *For example*, the specification is enabling for $R4=R5=H$. It is not seen, for example, where in the specification, enablement is present for X is an aryl group or halogen (see below for discussion relating to other variables). In addition, the specification provides limited disclosure with regards to the ability of the claimed compounds as components of pigments and dyes.

Enablement is considered in view of the Wands factors (MPEP 2164.01 (a)). These include: (1) breadth of the claims; (2) nature of the invention; (3) state of the prior art; (4) amount of direction provided by the inventor; (5) the level of predictability in the art; (6) the existence of working examples; (7) quantity of experimentation needed to make or use the invention based on the content of the disclosure; and (8) relative skill in the art.

All of the factors have been considered with regard to the claim, with the most relevant factors discussed below:

The breadth of claims: The claims are drawn to compounds with undefined substituents and heterocycles as well as generically claimed alkyl groups rendering the scope and breadth of the claims large.

The level of the skill in the art: The level of skill in the art is high. However, due to the unpredictability in the art of organic chemistry, it is noted that each embodiment of the invention is required to be individually assessed for viability.

The amount of direction provided by the inventor and the presence or absence of working examples: The direction and working examples provided in the specification for making of the compounds, is limited.

With regards to Z, enablement is present for Z being O and N. For example, it is uncertain if the Cu(II) mediated reaction would lead to cyclization if Z is S or other divalent moieties.

With regards to R4 and R5, enablement is present for $R4=R5=H$. The specification does not

provide citations (commercial or literature) for procuring the starting materials usable that could substitute for the lack of working examples with respect to non-enabled possibilities for R4 and R5. (That is the starting material compounds corresponding to compound (7) on page 13 of the specification wherein R2 & R4 or R3 & R5 form rings).

With regards to X variable, enablement is present for making X = O (i.e. X = OH, Acyl or ether linkage). It is unpredictable if the method taught in the specification of making X = n-butyl, would be extendable to making X = tert.alkyl because of the potential for competing elimination of hydrogen halide from the alkylating agent. Further, it is not seen where in the specification, enablement is present for making X = halogen, S-alkyl, N(alkyl)₂; or X=aryl when R1 is aryl.

The above-mentioned unpredictabilities and limitations establish that the contemporary knowledge in the art of organic synthesis would prevent one of ordinary skill in the art from accepting any claimed process described in the limited working examples on its face as universally applicable for making all structures encompassed by the claimed formulae.

The quantity of experimentation: For the reasons presented above, in order to utilize the invention as claimed, that is to make and use the claimed compounds, the skilled artisan would be presented with an undue amount of experimentation. The instant disclosure is broad and generic.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nizal S. Chandrakumar whose telephone number is 571-272-6202. The examiner can normally be reached on 8.30 am - 5 pm Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached at 571-272-0867 or Primary Examiner D. Margaret Seaman can be reached at 571-272-0694. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Nizal S. Chandrakumar



D. MARGARET SEAMAN
PRIMARY EXAMINER